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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,587	11/29/2001	Sacha Adrianus Fokke Taco Van Hijum	BO43667-CIP	2951

466 7590 07/03/2002

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,587

Applicant(s)

VAN HIJUM ET AL.

Examiner

Manjunath N Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a protein having fructosyltransferase activity, classified in class 435, subclass 193.
- II. Claims 6-9, drawn to polynucleotides, vector and host cell and method of making a polypeptide, classified in class 435, subclass 69.2.
- III. Claim 10, drawn to a process of producing an oligosaccharide or a polysaccharide using the protein, classified in class 435, subclass 97.
- IV. Claim 11, drawn to a chemically modified fructan, classified in class 514, subclass 54.
- V. Claim 12, drawn to a probiotic or symbiotic composition comprising *Lactobacillus* strain, classified in class 435, subclass 252.9.
- VI. Claims 13, drawn to a process of improving the microbial status in the mammalian colon by administering an effective amount of *Lactobacillus* strain, classified in class 424, subclass 93.45.
- VII. Claim 14, drawn to a process of improving the microbial status in the mammalian colon by administering an effective amount of an oligosaccharide or polysaccharide, classified in class 424, subclass 78.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, IV, V are patentably distinct from each other. The polypeptide of group I, the polynucleotide of group II, the fructan of group IV and the bacterial cell of group V are all

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different products and each comprise amino acid sequences and nucleotide sequences and organic compounds which are chemically unrelated, do not require each other for practice; have separate utilities, such as use of the group I polypeptide to catalyze a fructosyltransferase reaction versus the use of polynucleotide in a hybridization reaction and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of group I can be used to make specific antibodies as opposed to its use in the method of group III.

Invention I and VI, VII are patentably distinct from each other. The polypeptide of group I is a product that is neither used nor made in the methods of groups VI and VII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Invention II and III, VI, VII are patentably distinct from each other. The polynucleotide of group II is a product that is neither used nor made in the methods of groups III, VI and VII.

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They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions III and IV, V are patentably distinct from each other. The chemically modified fructan of group IV or the *Lactobacillus* cell composition of group V is neither made nor used in the method of making the oligosaccharide of group III. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions III, VI, VII are patentably distinct from each other. The method of producing oligosaccharide of group III, the method of improving the microbial status in a mammalian colon of groups VI, VII are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions IV and VI, VII are patentably distinct from each other. The chemically modified fructan of group IV is neither used nor made in the methods of groups VI, VII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the *Lactobacillus* cell can be used for making fermented milk as opposed to its use in the method of group VI.

Inventions V and VII are patentably distinct from each other. The *Lactobacillus* cell is a product which is neither used nor made in the method of group VII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

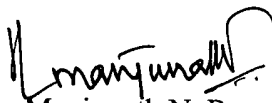
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N Rao whose telephone number is 703-306-5681.

The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.


Manjunath N. Rao
June 25, 2002